


Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)
Approved for use through xx/xx/200x. OMB 0651-00xx
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 118744-205	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on _____ Signature _____ Typed or printed name _____	Application Number 10/069,787	Filed February 28, 2007	
	First Named Inventor Christian Freyenberg		
	Art Unit 2617	Examiner I. P. MEHRA	
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p>			
I am the			
<input type="checkbox"/> applicant/inventor.		Signature	
<input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)		Kevin R. Spivak	
		Typed or printed name	
<input checked="" type="checkbox"/> attorney or agent of record. 43,148		202.955.7007	
Registration number _____		Telephone number	
<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34.		September 4, 2007	
Registration number if acting under 37 CFR 1.34 _____		Date	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.			
<input checked="" type="checkbox"/> *Total of <u>3</u> forms are submitted.			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Christian FREYENBERG
Appl. No.: 10/069,787
Conf. No.: 5010
Filed: February 28, 2002
Title: METHOD AND DEVICE FOR PROCESSING SIGNALING INFORMATION
IN A TELECOMMUNICATIONS NETWORK
Art Unit: 2617
Examiner: I. P. MEHRA
Docket No.: 118744-205

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF

Sir:

This request is submitted in response to the Final Office Action dated May 4, 2007, with an extension of time for one month. This request is filed contemporaneously with USPTO form PTO/SB/33, "Pre-Appeal Brief Request for Review" and form PTO/SB/31, "Notice of Appeal."

Remarks begin on page 2 of this paper.

REMARKS

I. THE REJECTION TO CLAIMS 1-9 UNDER 35 USC 103(A) AS UNPATENTABLE OVER AHUJA (U.S. PATENT NO. 6,222,837) IN VIEW OF BRAND (U.S. PATENT NO. 6,810,034), FURTHER IN VIEW WHITE (U.S. PATENT NO. 6,069,890)

Claims 1-9 have been rejected under 35 USC 103(a) as unpatentable over Ahuja in view of Brand, further in view of White. The rejection is respectfully traversed.

A. Invention

The invention generally relates to a method and apparatus which allows adding new services to a switching center without the need of adding the functionality to the switching center itself. In the invention, a request that cannot be serviced by the switching center is made to a telecommunications service server, which will perform the desired action. Thus, the new functionality can be provided to the customer without having to update all switching centers in the telephone network.

B. Arguments

The Examiner states that Ahuja and Brand discloses the “interchanging” and “converting” limitations, respectively. However, the Examiner newly cites White as disclosing the remaining claims limitations. (See paragraph 5, beginning on page 3 of the Office Action). Additionally, in response to Applicants arguments, in paragraph 6 of the Office Action, the Examiner notes that Brand indeed discloses the “conversion system” of the claimed invention. Applicants respectfully disagree, as none of the references, either alone or in combination, disclose the claimed invention.

Brand discloses a method which allows a calling party to transmit a message to a telephone belonging to a recipient party where the message is transmitted via an IP network. Applicant submits that neither Ahuja, as the Examiner agrees, nor Brand teaches the features of converting the signaling information in the switching center to at least one message which is transmitted to at least one telecommunications service server or that the at least one

telecommunication service server carries out telecommunications services which correspond to the at least one message. Rather, Brand teaches that a calling party transmits a message to a telephone belonging to a recipient party where the message is transmitted via an Internet Protocol network (abstract). Brand discloses that the message delivered from the calling party to the recipient party includes voice messages, audible messages containing data, and the like (col. 4, lns. 64-65). However, Brand fails to disclose any situation in which any device in the disclosed system carries out telecommunications services which correspond to the at least one message. Brand simply discloses a system whereby people can communicate with their telephones over the Internet. This does not relate to the claimed invention.

Additionally, White fails to disclose that new services can be added to an existing telephone network by making a switching center pass on signaling information to an additional telecommunications service server. Rather, White merely adds one more service to an existing telephone network (VoIP-telephony). However, White does not disclose a way of making a telephone network extendable by adding servers to which a switching center will connect and pass on signaling information when a new service, which cannot be processed by the switching center itself, is requested by a customer. This is demonstrated in various paragraphs of White, where the switching center processes internet-based services locally (a VoIP call requires passing on information over the Internet, however, the switching action is performed by the switching center): See for example, col. 8, lns 32-39: "...determines from the prefix *82 that the call is an Internet call. Responsive to its programming it connects the call to the gateway router 104..."; col. 9, lns. 15-18: "...switch 105 recognizes the prefix *82 as the Internet call prefix and may connect the call through end office 107 to the gateway router 104"; col. 10, lns. 53-55: "...having recognized the prefix *83 as requesting a telephone-to-computer voice communication...." In the claimed invention, the switching center does not recognize which service is requested by the customer, and therefore passes on the signaling information to a telecommunications service server which performs the requested action. For example, claims 1 and 6 require that the telecommunication service server carries out telecommunications services which correspond to the at least one message, wherein the telecommunication services are in addition to services provided by the switching center.

Finally, even assuming *arguendo* that signaling information is converted to a message and sent from a switching center over an Internet connection, the prior art does not disclose that a switching center may be extended in functionality by making it pass on signaling information to a telecommunications service server which will perform the desired action. Additionally, the claims are not directed to a switching center with extended functionality (White, for example, adds VoIP-telephony to a switching center), but rather to a system comprising a switching center and a telecommunications service server which allow for adding new services by changing the software of the telecommunications service server.

II. LACK OF MOTIVATION TO COMBINE THE REFERENCES

A. The Claimed Invention is Not Proved Obvious by the Office Action Merely Demonstrating that Each Element was Independently Known in the Prior Art

The notion that claims can be deemed obvious merely upon finding similar elements in separate prior parts would necessarily destroy virtually all patents and defeat the congressional purpose in enacting Title 35. “The TSM test captures a helpful insight: A patent composed of several elements is not proved obvious merely by demonstrating that each element was, independently, known in the prior art. Although common sense directs caution as to a patent application claiming as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the art to combine the elements as the new invention does. Inventions usually rely upon building blocks long since uncovered, and claimed discoveries almost necessarily will be combinations of what, in some sense, is already known.” KSR Intern. Co., 127 S.Ct. at 1731. Here, the Examiner simply states that the intended purpose for combining the references is that the “capabilities can be implemented in server [sic].

B. The Office Action is Improperly Using the Application as a Blueprint for Piecing Together Prior Art References

Even if all its limitations could be found in the total set of elements contained in the prior art references, a claimed invention would not be obvious without a demonstration of the existence of a motivation to combine those references at the time of the invention. "To reach a non-hindsight driven conclusion as to whether a person having ordinary skill in the art at the time of the invention would have viewed the subject matter as a whole to have been obvious in view of multiple references, the Board must provide some rationale, articulation, or reasoned basis to explain why the conclusion of obviousness is correct." *In re Kahn*, 441 F.3d 977, 987 (Fed. Cir. 2006).

The motivation for doing so is to provide services through the public telecommunications system." This statement wholly lacks any reason that would prompt the skilled artisan to combine elements to form the claimed invention.

In light of the above, Applicants respectfully submit that the rejection to claims 1-9 is improper and should be reversed by this Panel. Applicants respectfully request that a timely Notice of Allowance be issued in this case. If any additional fees are due in connection with this application as a whole, the Office is authorized to deduct such fees from deposit account no. 02-1818. If such a deduction is made, please indicate the attorney docket no. (118744-205) on the account statement.

Respectfully submitted,

BELL, BOYD & LLOYD LLP

BY 

Kevin R. Spivak

Reg. No. 43,148

Customer No. 29177

Dated: September 4, 2007